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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,379	09/04/2001	Wolfgang Moderegger	007413-049	1270

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EXAMINER	
MCALLISTER, STEVEN B	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,379	MODEREGGER ET AL.	
	Examiner	Art Unit	
	Steven B. McAllister	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) *44-48,57 and 58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43 and 49-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/3/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-43 and 49-56 in the reply filed on 7/26/2004 is acknowledged. The traversal is on the ground(s) that 1) the method claim 48 is improperly classified; and 2) the claimed method of Group I cannot be practiced by hand and is therefore not properly restricted from the appartus. This is not found persuasive because 1) determining a price of a service is a substantially different method than the method of creating and receiving bids on an RFQ as recited in Group I. Operations research encompasses the subject matter of determining price; 2) while it may be possible to perform the recited methods on a computer, as claimed they are not necessarily performed by a computer (it is noted that a database does not require a computer)

The requirement is still deemed proper and is therefore made FINAL.

Claims 44-48, 57 and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/26/2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Contract list" is unclear. In examining the claims, it was interpreted as a list of performances upon which the contract will be based.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-43 and 49-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-43 and 49-56 are non-statutory because they lack a technological element (such as recitation of a computer in carrying out the steps).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields (2002/00069154).

Fields shows providing a database having at least one performance description and one price for each performance; generating a list of performances; forwarding the list to a plurality of bidders; receiving a bid from at one of the bidders, each having a price determined by the bidder; evaluating the bids and selecting one; and automatically updating the database such that the price associated with the performances is updated to reflect the selected bid (pg. 7, par. 90).

As to claim 3, it is noted that the performance description is updated, for example specifying a number of moving parts in the invention.

As to claim 10, it is noted that since the database comprises a price term independent of region (national price) and a regional price, it is inherent that the database comprises a regional dependent price correction term.

As to claim 43, it is noted that since the past bids are used to recalculate and update the cost figures, those price comprise a plurality of past bid prices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 11, 12, 16, 20,21, 34-36, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields.

As to claims 4-6, Fields shows all elements except modifying or adding a performance and saving it in the database as a new performance. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding and saving performance descriptions as new performances in order to provide a more comprehensive listing of performance descriptions for future users to choose from.

As to claims 11 and 12, Fields shows all elements except determining the price of a performance from the region-independent price and a regionally dependent price correction term and updating only the independent price. However, to determine and update a regional price in this way is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by applying a regional correction term to an independent price in order to facilitate easy database maintenance.

Additionally as to claim 11, Fields shows all elements except determining the price of a performance from the region-independent price and a regionally dependent price correction term. However, it would have been an obvious matter of design choice to determine regional prices in this way since it does not appear that this particular

method of determining regional prices solves a particular problem or is for a specific purpose, and it appears that the method would function equally well with either method.

As to claim 16, Fields shows all elements except securing the list upon its completion. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to secure the created list in order to ensure that the list is not changed during the bidding process, creating inaccurate bids.

As to claim 20, Fields shows all elements except not disclosing the bid to the buyer. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to maintain bids secret until the deadline in order to prevent bid rigging.

Additionally, it is noted that claim 20 is interpreted as an obvious variant over claim 19. Were it determined that claim 20 is patentably distinct from claim 19, a species requirement would be necessary.

As to claim 21, Fields shows all elements except showing time of receipt of a bid. However, to do so is notoriously old and well known. It would have been obvious to one of ordinary skill in the art to include the time of receipt in order to maintain good housekeeping records and to provide proof that the bid arrived before the deadline.

As to claim 34, Fields shows all elements except automatic notification of losing bidders. However, to do so is notoriously old and well known in the art (e.g., ebay). It would have been obvious to one of ordinary skill in the art to modify the method Fields by providing such notification in order to ensure timely notification of losing bidders.

As to claims 35-36, Fields shows all elements except automatically sending a list of performances to the winning bidder. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to generate and provide such a list in order to facilitate the creation of a contract between the bidder and buyer in a timely manner.

As to claim 42, Fields shows all elements except the price description comprising a performance description comprising time to perform a performance, and a rate per hour. However, to do so is notoriously old and well known in the art (e.g., determining the cost of an auto repair by retrieving the "book rate" time to perform the repair and multiplying it by the labor rate). It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing such a way of determining the price in order to quickly determine a price of a number of jobs based on differing complexity and labor costs.

Claims 17, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Slaight et al (2002/0077954).

As to claims 17, 31 and 32, Fields shows all elements except receiving repeated bids by a bidder, and providing bid information back to bidders so they can modify their bids. Slaight shows these steps. It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing feedback and allowing repeated bids in order to assist the bidder in fixing problems in his bid.

As to claim 27-30, Fields shows all elements except generating a synthetic price from the ideal price calculated from the bid prices. Slaight shows this element (see e.g., Fig. 33). It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing a synthetic price as claimed in order to assist in evaluating bids.

As to claim 28, Fields in view of Slaight show making the price available to bidders.

Claims , 22-25, 37, 49-56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Vashistha et al (2001/0051913).

As to claim 37 and 49, Fields shows archiving a plurality of performances, each including a performance description and price; generating a list of desired performances; distributing the list to bidders; receiving a bid from at least one bidder including a price assigned to at least one performance; evaluating the received bids and selecting a bid; updating the archived descriptions with prices from the selected bid. Fields does not show that the selected bid is selected automatically. Vashistha show this. It would have been obvious to one of ordinary skill in the art to modify the method of Fields by automatically selecting a bid in order to reduce the amount of manual labor required in selecting the bid.

As to claim 52, Fields shows all elements except adding a performance. However, to do so is notoriously old and well known in the art. It would have been

obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding performance descriptions in order to allow for bidding on performances not contemplated by the existing database.

Regarding claims, 54 and 55, all elements are shown (e.g., Figs. 5, 7, 8 of Vashistha).

As to claim 56, Fields in view of Vashishta show comparing price among bidders, and versus the estimate; and determining negative performance via "virtual reputation" (e.g., Fig. 8 of Vashistha). It does not explicitly show selecting based on these elements. However, selecting a bid based on bid price, estimated price and historical information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to choose the best blend of low price and high quality.

As to claims 22 and 23, Fields in view of Vashishta show evaluating the bids based on ideal price (comprising lowest price), estimated price, deviation from the lowest price and past performance.

As to claim 24, Fields in view of Vashishta show all elements except automatically determining a deviation from the ideal price. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Fields by providing a deviation in order to assist in determining the best bid.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER